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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,190	12/22/2000	Timo Kinnunen	367.39429X00	8071

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EXAMINER

HASHEM, LISA

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/742,190	KINNUNEN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Lisa Hashem	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## FINAL DETAILED ACTION

### *Specification*

1. The amendment filed June 3, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: ‘...which may be in a look up table containing locations from which components are selectable with at least one of the locations being the memory of the radiotelephone 1 (not illustrated)...’.

Applicant is required to cancel the new matter in the reply to this Office Action.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 3 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, ‘...including a look-up table wherein the table contains entries of location from which components are selectable...’ which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), **at the time the application was filed**, had possession of the claimed invention. The specification filed on June 3, 2005 includes the following new subject matter ‘...which may be in a look up table containing locations from which components are selectable with at least one of the locations being the memory of the

radiotelephone 1 (not illustrated)...'. This new matter added to the specification is not entitled to the filing date of the instant application.

### *Claim Objections*

4. Claim 1 is objected to because of the following informalities: the phrase '...time, date and location...' is missing a comma (,) after date. Appropriate correction is required.

5. Claim 1 is objected to because of the following informalities: Examiner assumes the device '...communications device...' should be spelled '...communication device...'. Appropriate correction is required.

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-8, 10, and 12- 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,108,688 by Nielsen in view of U.S. Patent Application Publication Number 2004/0014459 by Shanahan.

Regarding claim 1, Nielsen discloses a communication device (sender's computer system or terminal) including a messaging user interface (Fig. 2; col. 3, lines 36-40), the interface including means for composing text for inclusion in a message (col. 3, lines 64-65; col. 4, lines 14-17), means for selecting at least one of time, date, and location conditions (e.g. deadline to open message) under which the message may be opened by a recipient (Fig. 2, 30) (col. 4, lines 17-31) and means for storing said the message together with a message header

holding the at least one of time, date, and location conditions under which the message may be opened by the device of the recipient in a memory (database) of the communication device (col. 5, lines 35-56).

Nielsen does not disclose means for selecting a component for inclusion in a message and the message may be opened by a device of a recipient.

Shanahan discloses a device (Fig. 4A, 20; section 0022, lines 1-10) including a messaging user interface (section 0043, lines 1-23), the interface including means for selecting a component (e.g. audio or video files) for inclusion in a message or signature file, means for selecting at least one of time, date, and location conditions under which the message may be opened by the device of a recipient (e.g. called party) and means for storing said component as a message holding the at least one of time, date, and location conditions under which the message may be opened by the device of the recipient in a memory of the device (section 0045, lines 1-13; section 0057, line 1 – section 0058, line 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Nielsen to include means for selecting a component for inclusion in a message and the message may be opened by a device of a recipient as taught by Shanahan. One of ordinary skill in the art would have been lead to make such a modification to allow selecting a component to be included in a message that may be opened by a device of a recipient.

Regarding claim 2, a device as claimed in claim 1 mentioned above, wherein Nielsen further discloses in which the message header further contains information descriptive of a content of the message (col. 3, lines 51-64; col. 5, lines 50-51).

Regarding claim 3, a device as claimed in claim 1 mentioned above, wherein Shanahan further discloses including a look-up table wherein the table contains entries of locations from which components are selectable (section 0046, line 1 – section 0048, line 9).

Regarding claim 4, a device as claimed in claim 3, wherein Shanahan further discloses at least one of the locations is the memory of the communication device (section 0046, lines 9-15; section 0048, lines 1-6).

Regarding claim 5, a device as claimed in claim 1 mentioned above, wherein Shanahan further discloses the message includes a plurality of components and associated presentation files (section 0046, lines 1-15; section 0049, lines 1-10; section 0052, lines 1-14; section 0054, line 1- section 0055, line 11).

Regarding claim 6, a device as claimed in claim 1 mentioned above, wherein Shanahan further discloses in which at least one component is a multimedia file (section 0049, lines 1-10).

Regarding claim 7, a device as claimed in claim 1 mentioned above, wherein Shanahan further discloses including means for creating a presentation file associated with said component, said file being stored with said message (section 0052, lines 1-14; section 0054, line 1- section 0055, line 11).

Regarding claim 8, a device as claimed in claim 7 mentioned above, wherein Shanahan further discloses the presentation file contains parameters relating a size and position of a component comprising a video image (section 0054, lines 1-18).

Regarding claim 10, a device as claimed in claim 7 mentioned above, wherein

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Shanahan further discloses the presentation file contains parameters relating to a color and font of a component inherently comprising a text string (section 0055, lines 1-11).

Regarding claim 12, a device as claimed in claim 1 mentioned above, wherein Nielsen further discloses including means for formatting the message as an email (col. 2, lines 57-66; col. 4, lines 14-17).

Regarding claim 13, a device as claimed claim 1 mentioned above, wherein Shanahan further discloses including wireless network interface means (Fig. 4a and 4b; section 0043, lines 1-23).

Regarding claim 14, a device as claimed in claim 1, wherein Shanahan further discloses the device is a radio telephone or wireless telephone (Fig. 4A, 20; section 0022, lines 1-10).

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen in view of Shanahan as applied to claim 7, and in further view of U.S. Patent No. 5,781,186 by Jennings.

Regarding claim 9, a device as claimed in claim 7 mentioned above, wherein Shanahan further discloses the presentation file contains a component comprising an audio recording (section 0052, lines 1-14).

Nielsen in view of Shanahan do not disclose parameters relating to a volume of an audio recording.

Jennings discloses a communication device (Fig. 1, 106) including a messaging user interface, the interface including means for selecting a component for inclusion in a message, means for selecting conditions under which the message may be opened by a device of a recipient (col. 1, lines 32-39; col. 2, lines 36-40; col. 4, lines 5-10; col. 4, line 53 – col. 5, line

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14) and means for storing said component as a message together with a message header in a memory of the communication device (see Abstract; col. 2, line 65 – col. 3, line 36). Wherein Jennings further discloses the presentation file inherently contains parameters relating to a volume of a component comprising an audio recording (col. 1, lines 11-30; col. 4, line 48 – col. 5, line 34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Nielsen in view of Shanahan to include parameters relating to a volume of an audio recording as taught by Jennings. One of ordinary skill in the art would have been lead to make such a modification to allow a sender to modify the volume of the audio recording.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen in view of Shanahan as applied to claim 1, and in further view of U.S. Patent No. 5,781,186 by Jennings.

Regarding claim 11, a device as claimed in claim 1 mentioned above, wherein Nielsen in view of Shanahan do not disclose means for formatting the message as an attachment to a short text message.

Jennings discloses a communication device (Fig. 1, 106) including a messaging user interface, the interface including means for selecting a component for inclusion in a message, means for selecting conditions under which the message may be opened by a device of a recipient (col. 1, lines 32-39; col. 2, lines 36-40; col. 4, lines 5-10; col. 4, line 53 – col. 5, line 14) and means for storing said component as a message together with a message header in a memory of the communication device (see Abstract; col. 2, line 65 – col. 3, line 36). Wherein



Jennings further discloses means for formatting the message as an attachment to a short text message (see Abstract; col. 5, lines 35-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the communication device of Nielsen in view of Shanahan to include means for formatting the message as an attachment to a short text message as taught by Jennings. One of ordinary skill in the art would have been lead to make such a modification to allow a sender to attach the message to a short text message.

***Response to Arguments***

10. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

11. Accordingly, this action is **FINAL**.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US Patent Application Publication No. 2001/0050977 by Gerszber et al disclose a method of alerting a user of an occasion date in a phone having a mode screen displaying function

13. Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Or faxed to:**

(571) 273-8300 (for formal communications intended for entry)

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**Or call:**

(571) 272-2600 (for customer service assistance)

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa Hashem whose telephone number is (571) 272-7542. The examiner can normally be reached on M-F 8:30-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LH

lh

August 29, 2005

  
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SUPERVISORY PATENT EXAMINER  
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